

REMARKS/ARGUMENTS

Favorable consideration of this application, as presently amended, is respectfully requested.

Claims 1-45 are pending in this application. Claims 1, 2, 4-8, and 43 have been amended without the addition of any new matter to require that there are at least two detecting devices (first and second means for detecting in Claim 43) that detect a leading edge of the first sheet before that sheet reaches pull-out rollers as shown and explained relative to FIGS. 12, 13A, and 15, for example.

The outstanding Office Action presents a rejection of Claims 1-45 under 35 U.S.C. § 103(a) as being unpatentable over Byeon et al. (U.S. Patent No. 6,381,441, “Byeon”) in view of Tamura (U.S. Published Patent Application No. 2001/0022422).

The rejection of Claims 1-45 under 35 U.S.C. § 103(a) as being unpatentable over Byeon in view of Tamura is respectfully traversed.

Turning first to independent Claims 1 and 43, these independent claims now require that there must be at least two detecting devices (first and second means for detecting in Claim 43) that detect a leading edge of the first sheet before that sheet reaches pull-out rollers that are defined to be the first rollers downstream from the sheet separating device in the sheet feeding direction.

Byeon does disclose a plurality of detecting devices (means for detecting leading sheet edges) but fails to teach or suggest that any are positioned between the pickup roller assemblies 55, 56, and 57 (that appear to correspond to the Claim 1 “sheet pick-up device” or the Claim 43 “means for picking up a first sheet”), much less that any are positioned to detect the leading edge of a sheet before it can reach the first set of unlabeled rollers that are downstream in a sheet feeding direction from the pickup roller assemblies 55, 56, and 57.

While Tamara can be argued to teach adding a sheet separating device comprised of sheet feeding roller 5 and retard roller 4 that is between the pick-up roller 3 and the pull-out rollers 2 with a detecting device or means for detecting sensor 1 that will sense a leading end of a sheet before it reaches the pull-out rollers 2 (see paragraphs [0063] – [0066]), there is no teaching or suggestion in Tamara of the at least a second such detecting device or means for detecting as recited by amended Claims 1 and 43.

Accordingly, even if some articulated reasoning with some rational underpinning to support the suggested modification of Byeon by Tamara were set forth by the outstanding Action, this combination still fails to teach all the limitations of independent Claims 1 and 43 so that there has been no establishment of a *prima facie* case of obviousness. See MPEP §2143.03.

Accordingly, withdrawal of the above-noted rejection of Claims 1 and 43 vis respectfully requested.

As Claims 2-14 depend directly or indirectly from independent Claim 1 so as to incorporate all of the limitations thereof, dependent Claims 2-14 are respectfully submitted to patentably define over the applied references for at least the same reasons as parent independent Claim 1.

In addition, Claims 2-14 add features to parent independent Claim 1 that are not taught or suggested by Byeon and/or Tamara, considered alone or together in any proper combination and are respectfully submitted to patentably define over these references for this reason as well. Note, for example, the plural thresholds of Claims 2, 3, and 6, the detecting device placements required by Claims 4-9, the displays of Claims 8 and 9, and the slip ratios of Claims 7-11, none of which has been considered or appropriately treated by the outstanding Action.

Turning to independent Claims 15, 29, 44, and 45, these claims do not simply recite a sheet feeding device as in claims 1 and 43. Instead, these claims recite an image reading or forming apparatus that has an image reading device (means for reading in Claims 44 and 45) that reads “an image of an original document” where the sheets being fed have to be individual original documents that will be so read after being fed to the recited “image reading position” by the recited feeding device (“means for feeding” in Claims 44 and 45). Thus, while each original document has a sheet form, it is different from the sheets for recording that are present in relied upon cassette 29 of Tamura (see paragraph [0066]) or the cassettes 51, 52, and 53 of Byeon (see col. 5, lines 39-49).

As neither Byeon nor Tamura teach all of the above-noted subject matter of independent Claims 15, 29, 44, and 45, there has been no establishment of a *prima facie* case of obviousness as to these claims. See MPEP §2143.03. Accordingly, withdrawal of this rejection of Claims 15, 29, 44, and 45 is respectfully requested.

Claims 16-28 depend directly or indirectly from independent Claim 15 so as to incorporate all of the limitations of this claim and Claims 30-42 depend directly or indirectly from independent Claim 29 so as to incorporate all of the limitations of this claim. Accordingly, withdrawal of the rejection of Claims 16-28 and 30-42 as being unpatentable over Byeon in view of Tamura under 35 USC § 103(a) is also respectfully requested.

In addition, 16-28 and 30-42 add features to their respective parent independent claims (15 and 29) that are not taught or suggested by Byeon and/or Tamura considered alone or together in any proper combination and are respectfully submitted to patentably define over these references for this reason as well. Note, for example, the plural thresholds of Claims 16, 17, 20, 30, 31, and 34, the detecting device placements required by Claims 18-22 and 32-35, the displays of Claims 22, 23, 36, and 37, and the slip ratios of Claims 21-25

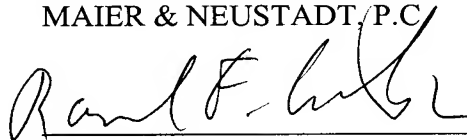
and 35-39, none of which has been considered or treated in an appropriate manner by the outstanding Action.

Furthermore with regard to means Claims 43-45, and as noted in the last response, the PTO reviewing court recently emphasized that the PTO must explain why it considers the “means” disclosed in the specification [to be] structurally equivalent to that embodied in [the reference].” See *Gechter v. Davidson* 116 F.3d 1454, 1460, 43 USPQ2d 1030, 1035 (Fed. Cir. 1997). No such explanation is included in the outstanding Action as to any of the “means” recited by Claims 43-45. If the PTO is to continue to reject Claims 43-45, compliance with the requirements set forth by the above-noted *Gechter* decision is respectfully requested.

As no other issues are believed to remain outstanding relative to this application, it is believed to be clear that this application is in condition for formal allowance and an early and favorable action to this effect is, therefore, respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



James J. Kulbaski
Attorney of Record
Registration No. 34,648

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)

Raymond F. Cardillo, Jr.
Registration No. 40,440